REMARKS

Claims 1-30 are in the application, of which claims 1, 2, 16, and 29 are in independent form. Claims 1 and 16 are amended. Claims 2, 14, and 15 were withdrawn.

In the Office Action mailed November 24, 2008 (the "Office Action), claims 1 and 3-13 stand rejected under 35 U.S.C. §§ 112 and 101. The Office Action rejects claims 1, 3-13, and 16-30 under § 102 as purportedly being anticipated by U.S. Patent Pub. No. 2002/0091767 to Munson ("Munson") or, in the alternative, under § 103 as allegedly being unpatentable over Munson.

With the amendments and remarks herein, the Applicants have addressed all of the issues raised in the Office Action. Accordingly, the Applicants submit that the Application is in condition for allowance and respectfully request the same.

CLAIM REJECTIONS UNDER § 112

Claims 1 and 3-13 stand rejected under § 112 as purportedly being indefinite for "...omitting essential structure..." Office Action Pg. 6 Para. 6. Specifically, the Office Action purports that the claims do not recite what happens if "the event owner is not interested" in trading a sponsorship. Office Action Pg. 7 Para. 1. Claim 1 recites steps for performing a method for "carrying out a sponsorship exchange." Claim 1. Therefore, the steps recited therein may be performed for/in conjunction with an event owner who is "interested in trading a sponsorship." Claim 1 has been amended to address this purported ambiguity.

CLAIM REJECTIONS UNDER § 101

Claims 1 and 3-13 were rejected under 35 U.S.C. § 101 as reciting ineligible subject matter. Applicants have amended claim 1 to clarify that the process steps are performed "using a computer." Support for these amendments may be found, for example, at Para [0021] of the specification, ("...the agent server presents request options to an event owner...."). As is well known in the art, a "server" is a computing device (computer) coupled to a network and configured to interact/communicate with

other entities. Therefore, a server includes hardware components, such as a processor, communication interface (*e.g.*, network card), and the like.

For a process claim to be eligible subject matter under 35 U.S.C. § 101, the process must either: (1) be tied to a particular machine or apparatus; or (2) transform a particular article into a different state or thing. In re Bilski, 545 F.3d 943 at 956 (Fed. Cir. 2008) (en banc). The current amendments tie the process steps of claim 1 to a "particular machine," *i.e.*, a computer. Accordingly, the Applicants respectfully submit that the claims recite eligible subject matter and request that the rejection under 35 U.S.C. § 101 be withdrawn.

The Office Action purports that claim 16 is an apparatus claim and, as such, it "must be structurally distinguishable from the prior art." Office Action Pg. 5 Para. 4(1). The Office Action further states that, "[a]pparatus claims cover what a device is, not what a device does..." Office Action Pg. 6 Para 1; citing Hewlett-Packard Co. vs. Bausch & Lomb Inc., (Fed Cir. 1990). The Applicants have amended claim 16 to clarify that the system is configured to operate in a particular way. Therefore, the claim language represents a structure of the system:

> "A system for carrying out a sponsorship exchange, comprising:
> an agent server communicatively coupled to a network; and
> a request database communicatively coupled to the agent server comprising a catalog of a plurality of services and/or tangible, non-monetary assets available to an event owner for putting on an event,
> wherein the **agent server is configured to present the catalog** to the event owner and **configured to** receive a request from the event owner for a service or tangible, non-monetary asset selected from the catalog over the network, wherein the agent server is **configured to associate the request with a sponsorship offer** comprising a sponsorship opportunity to be given to a provider of the requested service or tangible, non-monetary asset at the event and a portion of the cost of the request defrayed by the sponsorship opportunity, and wherein the **agent server is configured to make the request and the associated sponsorship offer available** to one or more potential providers of the request over the network." Emphasis added.

Therefore, claim 16 does not recite mere "intended use" for the system and, as such, the features recited therein are entitled to patentable weight.

REJECTION OF CLAIMS 1 AND 3-13 AND 16-30 UNDER 35 U.S.C. §§ 102, 103

The Office Action rejects claims 1, 3-13, and 16-30 under 35 U.S.C. §§ 102 and 103 as purportedly being anticipated by Munson or, in the alternative, as allegedly being unpatentable over Munson.

A claim may be rejected under § 102, "...only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628 (Fed. Cir. 1987); emphasis added; *also see* MPEP § 2131. The "identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989); *also see* MPEP 2131.

To support a *prima facie* case of obviousness under § 103, the Office Action must offer a "clear articulation of the reason(s) why the claimed invention would have been obvious." KSR Intl. Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007); *also see* MPEP § 2143. The analysis supporting the rejection should be made explicit. *See* MPEP § 2143. Any rejection under § 103 must consider all the words in the claim. *See* In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970); *also see* MPEP § 2143.03. Therefore, the cited prior art must teach or suggest all the claim limitations. *See* In Re Royka 490 F.2d 981 (CCPA 1974).

As shown below, Munson fails to disclose all of the features recited in claims 1 and 3-30. Therefore, Munson does not anticipate these claims. Moreover, Munson fails to consider all the words of these claims (fails to teach or suggest all the claim limitations). Therefore, the Applicants respectfully traverse these rejections.

MUNSON DOES NOT DISCLOSE RECORDING A REQUEST OF AT LEAST ONE ASSET SUBMITTED BY AN EVENT OWNER IN CONNECTION WITH AN EVENT

Munson does not disclose recording a request as recited in the claims. Claim 1 recites,

> "A method for carrying out a sponsorship exchange, comprising:
> recording a request for at least one service or tangible, non-monetary asset submitted by an event owner for use in putting on an event;

presenting to the event owner a sponsorship offer to be associated with the request, wherein the sponsorship offer comprises a sponsorship opportunity to at least partially defray a cost of the request; and

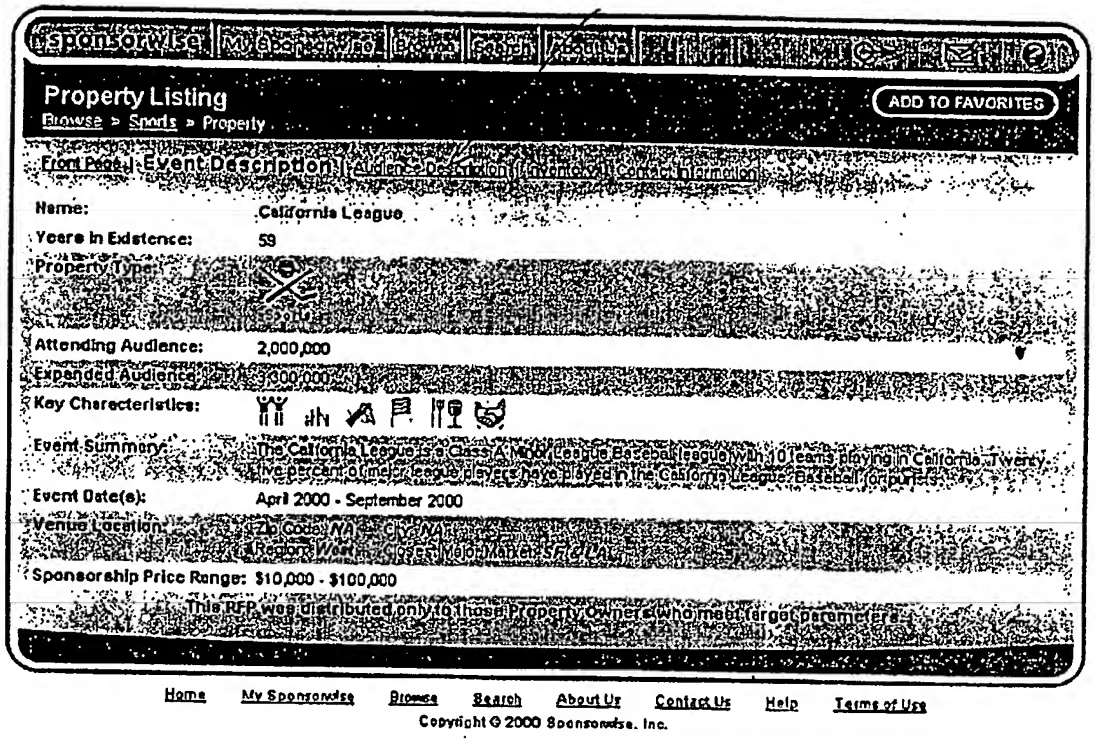
making the request and associated sponsorship offer available to one or more potential providers of the requested service or tangible, non-monetary asset." Emphasis added. Claims 16 and 29 recite similar features.

The disclosure teaches a sponsorship exchange to:

"set up a "quid pro quo benefiting the event owner in the form of no-cost, or nomincal/reduced fee **services or assets**. In turn, the **asset service provider** is getting product placement, branding or other advertising at a venue **it would otherwise have to pay for**..." Para. [0004]; emphasis added.

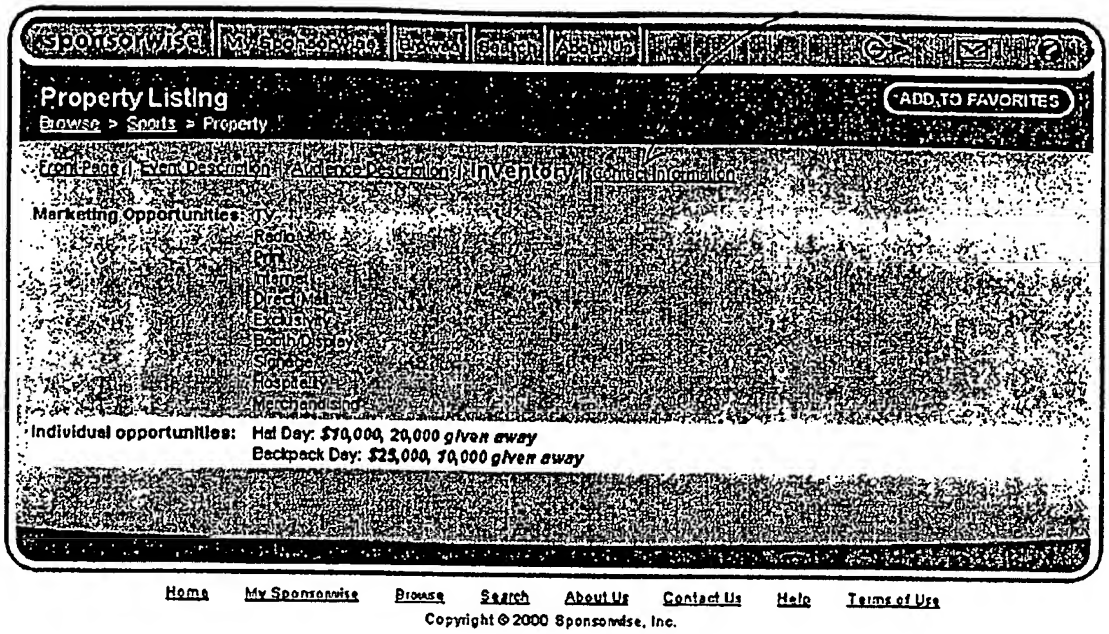
For example, the disclosure teaches that an event owner may have a need for "short term rental of computer hardware and software for an event, as well as any required IT or other support services." Para. [0021]. The event owner may submit a request for these services and/or assets ("...[the event owner] makes a request of specific computer hardware, software or services from an online catalog ... maintained by the agent server..."). Id; emphasis added. A sponsorship offer may be provided by which the event owner may defray at least a portion of the cost of the assets/services (computer hardware, IT services, etc.), in exchange for giving the service/asset provider a sponsorship opportunity at the event. Id.

Munson does not disclose recording a request as recited in the claims ("... a request for at least one service or tangible, non-monetary asset submitted by an event owner..."). Claim 1; emphasis added; *also see* claims 16 and 29. The Office Action cites Munson Figures 1-8, 24, 37-31 as disclosing a "request for at least one service or tangible, non-monetary asset" as recited in the claims. However, none of the Munson figures show a request as recited in the claims. For example, Figure 38 (cited in the Office Action), shows only a "range" of **monetary** sponsorship levels ("Sponsorship Price Range: $10,000-$100,000"):



In contrast, the claims do not recite a "sponsorship price range." Rather, the claims recite recording a request for "at least one **service or tangible, non-monetary asset**." Id.

Munson Figure 40 (also cited in the Office Action) shows an interface "which pertains to 'soon-to-expire' inventory, which includes a "listing of discontinued events..." Munson Para. 42. Therefore, the "inventory" shown on Figure 40 is intended to allow an organization to sell-off its leftover marketing merchandise (via a 'WiseBuysSM' liquidation service). Id.



Therefore, neither interface can be construed as "recording a **request** for at least one service or tangible, non-monetary asset... **for use in putting on an event**" as recited in the claims. Moreover, the Munson appendix states that the "inventory" listing is used by a "Liquidation engine (Wise-buys)" to dispose of inventory from expired events. Munson Appendix A & B at Pg. 27.

Since Munson only discusses sponsorship in terms of price (*e.g.,* sponsorship price range in Fig. 38), and not a request for "at least one service or tangible, non-monetary asset," it cannot disclose the features recited in the claims ("...recording a request for at least one service or tangible, non-monetary asset submitted by an event owner for use in putting on an event..."). Claim 1; emphasis added; *also see* claims 16 and 29.

MUNSON DOES NOT INHERENTLY DISCLOSE TRADING AT LEAST ONE SPONSORSHIP OPPORTUNITY TO DEFRAY A COST OF A REQUEST

The Office Action purports that "Munson inherently discloses 'trading at least one sponsorship opportunity to at least partially defray a cost of [a] request." The Applicants point out that it is well settled law that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic." MPEP § 2212(IV); emphasis original; citing In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In this case, the Office Action not only fails to "establish the inherency" of this purported teaching of Munson, but fails to show that such an exchange is even **possible** under Munson, (Munson fails to disclose any mechanism capable of receiving/recording a request for "at least one service or tangible, non-monetary asset" as recited in the claims.) Therefore, the Office Action fails to establish that the recited feature is inherently disclosed in Munson.

The Office Action further contends that "trading sponsorships" is well known in the art. However, "trading sponsorships" is **not what is claimed**. The claims recite, "...recording a request for at least one service or tangible, non-monetary asset..." Therefore, regardless of whether "trading sponsorships" is well known in the art; this purported knowledge does not anticipate nor render obvious this feature of the claims. Moreover, the Applicants respectfully submit that recording a request of the type recited in the claims was not well known in the art at the time the Application was filed. Therefore, if the Office Action wishes to maintain this assertion, the Applicants respectfully request supporting documentary evidence per 37 C.F.R. 1.104(d)(2):

> "...the [examiner] must point to some concrete evidence in the record in support of these findings to satisfy the substantial evidence test... If the examiner is relying on personal knowledge... the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding..." MPEP § 2144.04; *also see* 37 C.F.R. 1.104(d)(2).

MUNSON DOES NOT DISCLOSE A SPONSORSHIP OFFER TO AT LEAST PARTIALLY DEFRAY A COST OF A REQUEST

Claim 1 recites, "...wherein the sponsorship offer comprises a sponsorship opportunity to at least partially defray a cost of the request..." Emphasis added; *also see* claims 16 and 29. As discussed above, the disclosure teaches that a request for a "service or tangible, non-monetary asset" may be exchanged for a sponsorship opportunity to defray a cost of the service/asset to the event owner. *See* Para [0021].

Munson does not disclose a sponsorship opportunity as recited in the claims. As shown above, Munson discusses sponsorship only in terms of a monetary price (see Figure 38). To the Applicants' knowledge, Munson does not show or discuss an exchange of a sponsorship opportunity to defray the cost of a service/asset. Therefore, Munson cannot disclose this feature.

MUNSON DOES NOT ANTICIPATE OR RENDER THE CLAIMS UNPATENTABLE

As shown above, Munson fails to disclose at least, "...receiving a request for at least one service or tangible, non-monetary asset submitted by an event owner for use in putting on an event" and "...a sponsorship opportunity to at least partially defray a cost of the request..." Claim 1; *also see* claims 16 and 29. Therefore, Munson does not anticipate the claims nor render the claims obvious (since Munson fails to consider all the words in the claims). Therefore, the Applicants respectfully traverse the rejection of claims 1, 16, and 29. The Applicants also traverse the rejection of dependent claims 3-14, 16-28, and 30 since, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." In re Fine, 837 F.2d 1071, (Fed. Cir. 1988).

GENERAL CONSIDERATIONS

By the remarks provided herein, Applicants have addressed all outstanding issues presented in the Office Action. Applicants note that the remarks presented herein have been made merely to clarify the claimed invention from elements purported by the Office Action to be taught by the cited references. Such remarks should not be construed as acquiescence, on the part of the Applicants, as to the purported teachings or prior art status of the cited references, nor as to the characterization of the cited references advanced in the Office Action. Accordingly, the Applicants reserve the right to challenge the purported teachings and prior art status of the cited references at an appropriate time.

CONCLUSION

For the reasons discussed above, the Applicants submit that the claims are in proper condition for allowance, and a Notice of Allowance is respectfully requested. If the Examiner notes any further matters that may be resolved by a telephone interview, the Examiner is encouraged to contact Kory D. Christensen by telephone at (801) 578-6993.

Respectfully submitted,

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